



Patent US 221C4  
Attorney Docket: 612,404-387  
(formerly 267/242)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of:

**HELLER, Michael J.**

**Serial No.: 09/997,374**

Filed: November 29, 2001

For: HYBRIDIZATION OF  
POLYNUCLEOTIDES CONJUGATED  
WITH CHROMOPHORES AND  
FLUOROPHORES TO GENERATE  
DONOR-TO-DONOR ENERGY  
TRANSFER SYSTEM

Group Art Unit: 1637

Examiner: J. Fredman

**PETITION UNDER 37 C.F.R. §1.313(C)(2) FOR WITHDRAWAL FROM ISSUE**

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants hereby petition to withdraw the above-referenced application from issue as provided by paragraph 37 C.F.R. § 1.313(c)(2). Applicant has submitted the Request for Continued Examination herewith.

The Commissioner is hereby authorized to charge the petition fee (\$130.00) and any additional fees that may be required to Deposit Account No. 50-2862.

06/29/2004 AWONDAF1 00000059 502862 09997374

02 FC:1460 130.00 DA

**CERTIFICATE OF MAILING (37 C.F.R. §1.8)**

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as First Class Mail in an envelope addressed to Mail Stop Petition, Commissioner for Patents, Alexandria, VA 22313-1450.

Date of Deposit  
IR1:1056057.1

*Denise N. Doss*  
Denise N. Doss

Respectfully submitted,

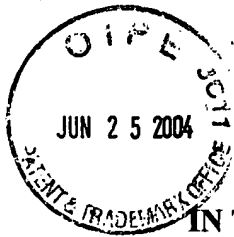
O'MELVENY & MYERS LLP

Dated: June 22, 2004

By: Diane K. Wong  
Diane K. Wong  
Reg. No. 54,550  
Attorneys for Applicants

DBM/DKW/dnd

O'Melveny & Myers LLP  
114 Pacifica, Suite 100  
Irvine, CA 92618-3315  
(949) 737-2900



Patent US 221C4  
Attorney Docket: 612,404-387  
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

**HELLER, Michael J.**

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DONOR-TO-DONOR ENERGY  
TRANSFER SYSTEM

Group Art Unit: 1637

Examiner: J. Fredman

**PETITION UNDER 37 C.F.R. §1.78(A)(3) FOR  
ACCEPTANCE OF CLAIM OF PRIORITY**

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicant hereby petitions for acceptance of a claim of priority that was presented in the above-referenced non-provisional application after the time period provided by paragraph 37 C.F.R. § 1.78(a)(2)(ii). A claim of priority, preliminary amendment correcting the relate-back statement in the specification, and a request for corrected filing receipt was filed on May 21, 2002, and was received by the OIPE on June 5, 2002. (Exhibit A) The entire delay between the date that the claim was due (March 29, 2002) and the date that the claim was filed (May 21, 2002) was unintentional.

06/29/2004 AWONDAF1 00000059 502862 09997374

03 FC:1454 1330.00 DA

CERTIFICATE OF MAILING (37 C.F.R. §1.8)

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*6/29/04*  
Date of Deposit  
IR1:1055992.1

*Denise N. Doss*  
Denise N. Doss

Applicant notes that the statement of priority as originally filed inadvertently omitted reference to the great-grandparent application, Serial No. 08/703,601, filed on August 23, 1996, now U.S. Patent No. 5,849,489. As seen in the documents attached as Exhibit A, the claim of priority is as follows:

-- This is a continuation of U.S. Application Serial No. 09/724,753, filed on November 28, 2000, which in turn is a continuation of U.S. Application Serial No. 09/123,638, filed on July 28, 1998, now U.S. Patent No. 6,162,603, which is in turn a continuation of U.S. Application Serial No. 08/703,601, filed on August 23, 1996, now U.S. Patent No. 5,849,849, which in turn is a continuation of U.S. Application Serial No. 08/232,233, filed on May 5, 1994, now U.S. Patent No. 5,565,322, which was filed under 35 U.S.C. §371 based on International Application PCT/US92/09827, filed November 6, 1992, which in turn is a continuation-in-part of U.S. Application Serial No. 07/790,262, filed November 7, 1991, now abandoned. Each of the above-identified patents and applications is expressly incorporated herein by reference. --

The Commissioner is hereby authorized to charge the petition fee (\$1,330.00) and any additional fees that may be required to Deposit Account No. 50-2862.

Respectfully submitted,

O'MELVENY & MYERS LLP

Dated: June 22, 2004

By: Diane K. Wong  
Diane K. Wong  
Reg. No. 54,550  
Attorneys for Applicants

DBM/DKW/dnd

O'Melveny & Myers LLP  
114 Pacifica, Suite 100  
Irvine, CA 92618-3315  
(949) 737-2900



Applicant: HELLER, Michael J. Attorney: JCK/DKW/mls  
Serial No.: 09/997,374 Docket No.: 267/242  
Filed: November 29, 2001  
For: HYBRIDIZATION OF POLYNUCLEOTIDES CONJUGATED WITH  
CHROMOPHORES AND FLUOROPHORES TO GENERATE DONOR  
...

Please acknowledge receipt of the following by affixing hereon the Patent and Trademark Office date stamp and returning this card to our office.

Enclosures:

1. Preliminary Amendment
2. Claim of Priority
3. Request for Corrected Filing Receipt (with redlined Filing Receipt)
3. Return Postcard

Date of Deposit: May 21, 2002



Exhibit A



Patent  
267/242

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Heller, Michael

Serial No.: 09/997,374

Filed: November 29, 2001

For: HYBRIDIZATION OF  
POLYNUCLEOTIDES CONJUGATED  
WITH CHROMOPHORES AND  
FLUOROPHORES TO GENERATE  
DONOR-TO-DONOR ENERGY  
TRANSFER SYSTEM

Group Art Unit: 1655

Examiner: Not Yet Assigned

**PRELIMINARY AMENDMENT**

Box AMENDMENT  
Commissioner for Patents  
Washington, D.C. 20231

Sir:

Please enter the following amendment in the above-referenced application:

**IN THE SPECIFICATION**

Please replace the paragraph beginning at page 1, line 7, with the following rewritten paragraph:

--This is a continuation of U.S. Application Serial No. 09/724,753, filed on November 28, 2000, which in turn is a continuation of U.S. Application Serial No. 09/123,638, filed on July 28, 1998, now U.S. Patent No. 6,162,603, which is in turn a

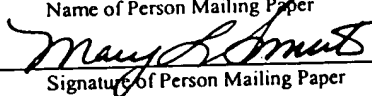
OC-110419.1

CERTIFICATE OF MAILING  
(37 C.F.R. §1.8a)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as First Class Mail in an envelope addressed to the Commissioner for Patents, Washington, D.C. 20231.

May 21, 2002  
Date of Deposit

Mary L. Smith  
Name of Person Mailing Paper

  
Signature of Person Mailing Paper

continuation of U.S. Application Serial No. 08/703,601, filed on August 23, 1996, now U.S. Patent No. 5,849,849, which in turn is a continuation of U.S. Application Serial No. 08/232,233, filed on May 5, 1994, now U.S. Patent No. 5,565,322, which was filed under 35 U.S.C. §371 based on International Application PCT/US92/09827, filed November 6, 1992, which in turn is a continuation-in-part of U.S. Application Serial No. 07/790,262, filed November 7, 1991, now abandoned. Each of the above-identified patents and applications is expressly incorporated herein by reference.--

### REMARKS

Applicant notes that the statement of priority as originally filed inadvertently omitted reference to the great-grandparent application, Serial No. 08/703,601, filed on August 23, 1996, now U.S. Patent No. 5,849,489. The statement of priority is correctly stated in the grandparent application, Serial No. 09/123,638, filed on July 28, 1998, now U.S. Patent No. 6,162,638 and has been corrected in the parent application Serial No. 09/724,753, filed on November 28, 2000. In addition, applicant notes that the Declaration of inventor Michael Heller, which accompanied the present application on its filing date of November 29, 2001, refers to U.S. Application Serial No. 08/703,601.

Favorable consideration and entry of the above amendments is respectfully requested. The Commissioner is hereby authorized to charge any fees that may be required to Deposit Account No. 12-2475.

Respectfully submitted,

LYON & LYON LLP

Dated: 5/20/2002

By John Kappos  
John Kappos  
Reg. No. 37,861  
Attorneys for Applicant

JCK/dkw  
633 West Fifth Street, 47th Floor  
Los Angeles, CA 90071-2066  
(949) 567-2300 or (213) 489-1600

**Version with Markings to Show Changes Made**

**In the Specification**

Please replace paragraph 1 on page 1 as follows:

This is a continuation of U.S. Application Serial No. 09/724,753, filed on November 28, 2000, which in turn is a continuation of U.S. Application Serial No. 09/123,638, filed on July 28, 1998, now U.S. Patent No. 6,162,603, which is in turn a continuation of U.S. Application Serial No. 08/703,601, filed on August 23, 1996, now U.S. Patent No. 5,849,849, which in turn is a continuation of U.S. Application Serial No. 08/232,233, filed on May 5, 1994, now U.S. Patent No. 5,565,322, which was filed under 35 U.S.C. §371 based on International Application PCT/US92/09827, filed November 6, 1992, which in turn is a continuation-in-part of [U.S. Application Serial No. 08/250,951, filed May 27, 1994, now U.S. Patent No. 5,532,129, which in turn is a continuation of] U.S. Application Serial No. 07/790,262, filed November 7, 1991, now abandoned. Each of the above-identified patents and applications is expressly incorporated herein by reference.





Patent  
267/242

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Heller, Michael

Serial No.: 09/997,374

Filed: November 29, 2001

For: HYBRIDIZATION OF  
POLYNUCLEOTIDES CONJUGATED  
WITH CHROMOPHORES AND  
FLUOROPHORES TO GENERATE  
DONOR-TO-DONOR ENERGY  
TRANSFER SYSTEM

)  
) Group Art Unit: 1655

)  
) Examiner: Not yet assigned

**REQUEST FOR CORRECTED FILING RECEIPT**

Commissioner for Patents  
Washington, D.C. 20231

Sir:

Applicant herein requests a corrected filing receipt for the above-identified patent application.

The Filing Receipt for the above application (copy enclosed) is incorrect in that it misstates the statement of priority. The correct "Continuing Data as Claimed by Applicant" should read:

THIS APPLICATION IS A CON OF 09/724,753 11/28/2000  
WHICH IS A CON OF 09/123,638 07/28/1998 PAT 6,162,603

OC-110411.1

**CERTIFICATE OF MAILING**  
(37 C.F.R. §1.8a)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as First Class Mail in an envelope addressed to the Commissioner for Patents, Washington, D.C. 20231.

Mary L. Smith

Name of Person Mailing Paper

May 21, 2002

Date of Deposit

Signature of Person Mailing Paper

WHICH IS A CON OF 08/703,601 08/23/1996 PAT 5,849,489  
WHICH IS A CON OF 08/232,233 05/05/1994 PAT 5,565,322  
WHICH IS A CON OF PCT/US92/09827 11/06/1992  
WHICH IS A CIP OF 07/790,262 11/07/1991 ABN

Applicants note that the statement of priority as originally filed inadvertently omitted reference to the great-grandparent application, serial no. 08/703,601, filed on August 23, 1996, now U.S. Patent No. 5,849,489. The priority claim has been corrected by amendment of even date herewith. Therefore, applicants respectfully request the issuance of a corrected filing receipt.

Respectfully submitted,

LYON & LYON LLP

Dated: 5/20/2002

By: John Kappos  
John Kappos  
Reg. No. 37,861  
Attorneys for Applicant

JCK/dkw  
633 West Fifth Street, Suite 4700  
Los Angeles, California 90071-2066  
(949) 567-2300



## UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
www.uspto.gov

APPLICATION NUMBER	FILING DATE	GRP ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO	DRAWINGS	TOT CLAIMS	IND CLAIMS
09/997,374	11/29/2001	1655	406	267/242	4	24	2

22249  
LYON & LYON LLP  
633 WEST FIFTH STREET  
SUITE 4700  
LOS ANGELES, CA 90071



CONFIRMATION NO. 4021

## UPDATED FILING RECEIPT



\*OC000000007809139\*

Date Mailed: 04/08/2002

Receipt is acknowledged of this nonprovisional Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Customer Service Center. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

## Applicant(s)

Michael J. Heller, Encinitas, CA;

## Assignment For Published Patent Application

Nanogen, Inc., San Diego, CA;

## Domestic Priority data as claimed by applicant

THIS APPLICATION IS A CON OF 09/724,753 11/28/2000

WHICH IS A CON OF 09/123,638 07/28/1998 PAT 6,162,603

WHICH IS A CON OF 08/232,233 05/05/1994 PAT 5,565,322

WHICH IS A 371 OF PCT/US92/09827 11/06/1992

WHICH IS A CIP OF 08/260,954 05/27/1994 PAT

WHICH IS A CON OF 07/790,262 11/07/1991 ABN

Which is a CON OF 08/703,601 08/  
PAT 5,849,

CON

CIP

## Foreign Applications

If Required, Foreign Filing License Granted 02/13/2002

Projected Publication Date: 07/18/2002

Non-Publication Request: No

Early Publication Request: No

\*\* SMALL ENTITY \*\*

RECEIVED

APR 12 2002

US PROSECUTION

**Title**

Hybridization of polynucleotides conjugated with chromophores and fluorophores to generate donor-to-donor energy transfer system

**Preliminary Class**

435

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**LICENSE FOR FOREIGN FILING UNDER**  
**Title 35, United States Code, Section 184**  
**Title 37, Code of Federal Regulations, 5.11 & 5.15**

**GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Office of Export Administration, Department of Commerce (15 CFR 370.10 (j)); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

**NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).



Patent  
267/242

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DONOR-TO-DONOR ENERGY  
TRANSFER SYSTEM

Group Art Unit: 1655

Examiner: Not Yet Assigned

CLAIM OF PRIORITY

Commissioner for Patents  
Washington, D.C. 20231

Sir:

Please be advised that this application is a continuation of U.S. Application Serial No. 09/724,753, filed on November 28, 2000, which is in turn a continuation of U.S. Application Serial No. 09/123,638, filed on July 28, 1998, now U.S. Patent No. 6,162,603, which is in turn a continuation of U.S. Application Serial No. 08/703,601, filed on August 23, 1996, now U.S. Patent No. 5,849,489, which in turn is a continuation of U.S. Application Serial No. 08/232,233, filed on May 5, 1994, now U.S. Patent No. 5,565,322, which was filed under 35 U.S.C. §371 based on International Application PCT/US92/09827, filed November 6, 1992, which in turn is a

OC-110415.1

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May 21, 2002  
Date of Deposit

Mary L. Smith  
Name of Person Mailing Paper

*Mary L. Smith*  
Signature of Person Mailing Paper

continuation-in-part of U.S. Application Serial No. 07/790,262, filed November 7, 1991, now abandoned. Applicant claims priority to all of the above patents and applications under 35 U.S.C §§ 119, 120, and all of the above patents and applications are expressly herein incorporated by reference in their entirety.

Respectfully submitted,

LYON & LYON LLP

Dated: 5/20/2002

By John Kappos  
John Kappos  
Reg. No. 37,861  
Attorneys for Applicant

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Los Angeles, CA 90071-2066  
(949) 567-2300 or (213) 489-1600